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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GARDERE / JAMES HARDIE			EXAMINER	
GARDERE WYNNE SEWELL, LLP			MARCANTONI, PAUL D	
1601 ELM STREET				
SUITE 3000			ART UNIT	PAPER NUMBER
DALLAS, TX 75201			1755	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/753,089	LUO ET AL.	
	Examiner Paul Marcantoni	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 7/9/07 amdmt and response.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-11 and 25-27 is/are pending in the application.
 - 4a) Of the above claim(s) 25-27 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 4-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1,4-11 and 25-27 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

Applicant's arguments filed 7/9/07 have been fully considered but they are not persuasive.

Between About:

The examiner did not make a rejection over these terms and it has original support for applicants' invention. Applicants state that the Federal Circuit in a 2000 decision routinely acknowledges it is definite. The examiner could not secure a copy of the decision yet would be interested to know exactly why specifically the Federal Circuit they found this term to be definite. The terms in and of themselves are opposites in their definitions as explained in the previous office action. However, it would appear that "between about" has been interpreted by the Federal Circuit to give the broadest meaning/coverage to the claim. This would mean that about supercedes and negates "between" so the term "between about" is synonymous with "about". This is how the examiner has thus interpreted the meaning of between about as no different than "about". Any other interpretation would not make sense and between about could certainly not mean the same as between.

ODP Rejection:

Claims 1 and 4-11 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all claims of U.S. Patent No. 6,606,248 B1 and 6,346,146 B1 (both Duselis). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a cement composite comprising a mixture of bleached and unbleached cellulose fibers.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 1755

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 USC 102:

Claims 1 and 4-11 remain rejected under 35 U.S.C. 102(a and e) as being anticipated by Duselis et al. '248 B1 or '146 B1.

Duselis et al. teach a composition comprising a combination or blend of bleached and unbleached cellulose fibers in amounts overlapping applicants' claims (see, for example, Duselis et al. 248 B1, col.5, lines 15-21). Duselis et al. thus anticipate applicants' claims.

35 USC 103 :

Claims 1 and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duselis et al. ("248 B1 or '146 B1) alone or in view of Cook et al. '726 B2 and Gregerson et al. (EP 263723).

Duselis et al. teach a composition comprising a combination or blend of bleached and unbleached cellulose fibers in amounts overlapping applicants' claims (see, for example, Duselis et al. 248 B1, col.5, lines 15-21). Duselis do not necessarily teach all the types of cellulose fibers claimed by applicants for their invention. Cook et al. (hereafter Cook) teaches examples of cellulose fibers that can be used for cement fiber reinforcement includes radiata pine, spruce, redwood, and douglas fir (see col.3, lines 60-67). It would have been an obvious design choice for one of ordinary skill in the art to use a specific cellulose fiber in Duselis cement/cellulose fiber composition because they are known for that use in the art according to Cook.

Also, Gregerson et al. (hereafter Gregerson) teaches adding cellulose fiber such as bleached or unbleached cellulose fiber to hydraulic binder or cement. Gregerson et al. teach conventional cellulose fiber sizes for length are 1.0 mm for bleached cellulose fibers and less than 4 mm for unbleached cellulose fibers (see p.6 under Fibres). This is thus a conventional size range for cellulose fibers and it would have been an obvious design choice for one of ordinary skill in the art to use this cellulose fiber size in cement. Note that this secondary Gregerson was necessary because Duselis did not explicitly teach what fiber sizes he uses for his invention. Nevertheless, it would have been obvious to one of ordinary skill in the art (according to Gregerson) to use conventionally known fiber sizes for cellulose fiber in the Duselis cement/cellulose fiber composition.

Previous Response:

ODP

The examiner maintains the ODP rejection is proper and Duselis does not limit his range of amounts for his mixture. Duselis '248 B1 teaches cellulose fibers may be bleached, unbleached, or mixtures thereof. Again, Duselis is not limited to any particular ranges but is inclusive of any mixture between bleached fibers and unbleached fibers. This reference is good for all that it teaches and it is inclusive of applicants' claimed mixture.

The applicants argue Kaplan case law noting that the examiner's rejection over Duselis rejection falls under a "dominating" effect in accordance with his case law. The examiner disagrees. A reference is good for all that it teaches and Duselis is inclusive of any mixture of bleached and unbleached cellulose fibers. The applicants are essentially asking the examiner to ignore the teaching of this reference (mixtures of bleached and unbleached cellulose fibers) which is inclusive of mixtures and he can not and will not do so.

Duselis 102 and 103:

The applicants acknowledge that Duselis teaches a mixture or combination of bleached and unbleached fibers yet do not teach their specific range of amounts. In rebuttal, the examiner maintains that Duselis is not limited to particular ranges of amounts and teaches any mixtures of bleached and unbleached fibers including from zero to 100 wt% for each cellulose fiber (bleached or unbleached) component under "and mixtures thereof" as taught by Duselis.

Present Response:

The applicants repeat arguments previously presented and the examiner has pasted the same response as noted above for further review and response to these reiterations.

The applicants also argue that the "benefits" of bleached and unbleached fibers were not recognized at the time of filing of their ODP references. This is not relevant especially since these ODP references sufficiently teach applicants' invention and the *prima facie* case of obviousness has been met. Applicants also argue that bleached fibers are not required. The point is not relevant since the references teaches it can be used and thus applicants cannot ignore the totality of the teaching of the reference.

The Duselis et al. '248 B1 reference teaches the cellulose fibers may be bleached, unbleached, partially bleached or mixtures thereof. (col.5, lines 16-17). The examiner maintains that Duselis is not limited to particular ranges of amounts and teaches any mixtures of bleached and unbleached fibers including from zero to 100 wt% for each cellulose fiber (bleached or unbleached) component under "and mixtures thereof" as taught by Duselis. This is and remains the examiner's position regarding the prior art meaning of "or mixtures thereof" as being for each component (bleached fiber and unbleached fiber) both being in the range of 0 to 100 wt%.

The applicants next argue "dry formulation" versus they allege in their own invention is total cellulose fibers. A review of applicants' claim 1 also reveals that it is a dry formulation as there is no water in claim 1. Applicants' own total amounts of bleached and unbleached cellulose fibers is directed to their own dry formulation so this argument is not convincing.

The applicants response and arguments were considered and not found persuasive for the reasons in the previous office action and those set forth above. The finality of this office action is now proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1755

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755